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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,809	02/08/2002	Marilyn Anne Anderson	18-01	3677

23713 7590 06/20/2003

GREENLEE WINNER AND SULLIVAN P C  
5370 MANHATTAN CIRCLE  
SUITE 201  
BOULDER, CO 80303

EXAMINER

KUBELIK, ANNE R

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 06/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/072,809

Applicant(s)

ANDERSON ET AL.

Examiner

Ariane R. Kubelik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-54 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other:  |

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claim 3 and 27, drawn to a nucleic acid encoding a protein of SEQ ID NO:58, classified in class 536, subclass 23.6.
  - II. Claim 4, drawn to a nucleic acid encoding a protein of SEQ ID NO:59, classified in class 536, subclass 23.6.
  - III. Claim 5, drawn to a nucleic acid encoding a protein of SEQ ID NO:60, classified in class 536, subclass 23.6.
  - IV. Claim 6, drawn to a nucleic acid encoding a protein of SEQ ID NO:61, classified in class 536, subclass 23.6.
  - V. Claims 14-17, 19-25, 28-29 and 32-34, drawn to a nucleic acid encoding a protein of SEQ ID NO:8, 14, 16 or 18, a method for protecting a plant, and cells transformed with the nucleic acid, classified in class 800, subclass 279.
  - VI. Claims 28 and 32-33, drawn to a method for protecting a plant with a nucleic acid encoding a protein of SEQ ID NO:2, classified in class 800, subclass 279.
  - VII. Claims 28 and 32-33, drawn to a method for protecting a plant with a nucleic acid encoding a protein of SEQ ID NO:3, classified in class 800, subclass 279.
  - VIII. Claims 28 and 32-33, drawn to a method for protecting a plant with a nucleic acid encoding a protein of SEQ ID NO:4, classified in class 800, subclass 279.
  - IX. Claims 28 and 32-33, drawn to a method for protecting a plant with a nucleic acid encoding a protein of SEQ ID NO:5, classified in class 800, subclass 279.

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- X. Claims 28 and 32-33, drawn to a method for protecting a plant with a nucleic acid encoding a protein of SEQ ID NO:6, classified in class 800, subclass 279.
- XI. Claims 35-36, drawn to plants and progeny of plants engineered to express a defensin-like molecule, classified in class 800, subclass 301.
- XII. Claim 37, drawn to genetic constructs comprising a promoter operably linked to a nucleic acid encoding a defensin-like molecule and a second promoter operably linked to a nucleic acid encoding a protease inhibitor, classified in class 435, subclass 320.1.
- XIII. Claim 40, drawn to a protein of SEQ ID NO:58, classified in class 530, subclass 300.
- XIV. Claim 41, drawn to a protein of SEQ ID NO:59, classified in class 530, subclass 300.
- XV. Claim 42, drawn to a protein of SEQ ID NO:60, classified in class 530, subclass 300.
- XVI. Claim 43, drawn to a protein of SEQ ID NO:61, classified in class 530, subclass 300.
- XVII. Claims 49-54, drawn to a protein of SEQ ID NO:8, 14, 16 or 18, classified in class 530, subclass 300.

The inventions are distinct, each from the other because of the following reasons:

Claims 1-2, 7-13, 18, 26 and 30-32 links inventions I-XI. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claims, claims 1-2, 7-13, 18, 26 and 30-32. Upon the allowance of the linking claims, the restriction requirement as to the linked inventions shall be withdrawn and any claims depending from or otherwise including all the limitations of the allowable linking claims will be entitled to examination in the instant application. Applicants are advised that if any such claims depending from or including all the limitations of the allowable linking claims is/are presented in a continuation or divisional

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application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Claims 3 and 27 links inventions V and VIII-XI. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claims, claims 3 and 27. Upon the allowance of the linking claims, the restriction requirement as to the linked inventions shall be withdrawn and any claims depending from or otherwise including all the limitations of the allowable linking claims will be entitled to examination in the instant application. Applicants are advised that if any such claims depending from or including all the limitations of the allowable linking claims is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Claims 38-39 and 44-48 links inventions XIII-XVII. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claims, claims 38-39 and 44-48. Upon the allowance of the linking claims, the restriction requirement as to the linked inventions shall be withdrawn and any claims depending from or otherwise including all the limitations of the allowable linking claims will be entitled to examination in the instant application. Applicants are advised that if any such claims depending from or including all the limitations of the allowable

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linking claims is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Groups I-X are independent and distinct. Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute **independent and distinct** inventions within the meaning of 35 U.S.C. 121. Each sequence requires an independent search of the sequence databases. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq (see MPEP 803.04 and 2434).

Groups XIII-XVII are independent and distinct. Different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute **independent and distinct** inventions within the meaning of 35 U.S.C. 121. Each sequence requires an independent search of the sequence databases. Absent evidence to the contrary, each such protein sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq (see MPEP 803.04 and 2434).

Groups I-X are independent and distinct from Groups XIII-XVII. DNA and protein differ in composition, structure and function.

The plants of Group XI are independent and distinct from the plants of Groups I-X and the proteins of XIII-XVII. The plants of Group IX are not transformed with the same nucleic acids as the plants of Groups I-X and are not used in the production of the proteins of Groups XIII-XVII.

The constructs of Group XII are independent and distinct from the nucleic acids of groups I-X and XIII-XVII. The constructs of Group IX are distinct chemical compounds from the nucleic acids of Groups I-X and the proteins of Groups XIII-XVII.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, fields of search, and classification, restriction for examination purposes as indicated is proper.

Applicant is advised that for the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Sequence Rules***

2. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825.



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Claims 28 and 33 state that SEQ ID NOs:2-5 are amino acid sequences. However, in the sequence listing, SEQ ID NOs:2-5 are nucleic acid sequences. Correction of this inconsistency is required.

Full compliance with the sequence rules is required in response to this Office action. A complete response to this Office action must include both compliance with the sequence rules and a response to the issues set forth below. Failure to fully comply with both of these requirements in the time period set forth in this Office action will be held to be non-responsive.

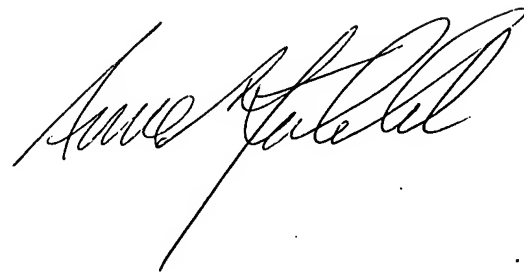
3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (703) 308-5059. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service at (703) 308-0198.

Anne R. Kubelik, Ph.D.

June 17, 2003

A handwritten signature in black ink, appearing to read "Anne R. Kubelik", with a long, sweeping underline that extends to the right.